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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,438	02/11/1999	MURRAY C. MAYTOM	PC10015AJTJ	8766

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EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/23/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/248,438

Applicant(s)

MAYTOM ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The Request for a Continued Examination (RCE) under 37 CFR 1.1114 based on parent Application No. 09/248438 filed on February 8, 2002 is acceptable and a RCE has been established. An action on the RCE follows.
2. Receipt of applicants' remarks and the declaration by Murray Craig Maytom is acknowledged.

Double Patenting Rejection

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 5-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-36 of copending Application No. 08/549,792, in view of Tay et al. (Medline Abstract, AN 96186389), Beretta et al. (Medline Abstract, AN 94136073) and Chancellor et al. (Medline Abstract, AN 94182317).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the U.S. application Serial No. 08/549,792, similar to the instant claims, are drawn to methods of treating sexual dysfunction broadly and male erectile dysfunction.

Art Unit: 1617

U.S. application Serial No. 08/549,792 does not expressly claim the treated subject is with injured spinal cord.

3. However, Tay et al. teaches that erectile dysfunction caused by injured spinal cord may be psychogenic, not organic. See the abstract. Berretta et al. and Chancellor et al. teach that vasoactive compounds are known to be useful for treatment of erectile dysfunction in men with injured spinal cord. See the abstracts.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the vasoactive compounds herein for the treatment of ED in men with spinal cord injury, including those who exhibits essentially no residual erectile function.

4. A person of ordinary skill in the art would have been motivated to employ the vasoactive, compounds herein for the treatment of ED in men with spinal cord injury, who exhibits essentially no residual erectile function because the general established mechanism of sildenafil indicates it will be useful for treatment of ED in men with proper corpus cavernosum tissue, including those with injured spinal cord. A person of ordinary skill in the art would have reasonable expected that sildenafil would be useful for treatment of ED in men including those exhibits essentially no residual erectile function, particularly in view of the fact that not all spinal cord injuries cause erectile dysfunction and not all the erectile dysfunction caused by spinal cord injury are organic. Further, a person of ordinary skill in the art would have been motivated to employ the vasoactive compounds herein for the treatment of ED in men with spinal cord injury because vasoactive compounds useful for treating erectile dysfunction are known to be useful for treating erectile dysfunction caused by spinal cord injury. Finally, an agent known to be useful

Art Unit: 1617

for treating erectile dysfunction caused by spinal cord injury in men would have reasonably expected to be useful for treating erectile dysfunction caused by spinal cord injury in any men, including those who exhibit essentially no residue erectile function.

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejection 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/28902 (of record) in view of Tay et al. (Medline Abstract, AN 96186389), Beretta et al. (Medline Abstract, AN 94136073) and Chancellor et al. (Medline Abstract, AN 94182317).

WO 94/28902 teaches that the compounds of the claims are vasoactive compounds, known to be useful in the treatment of male erectile, sexual dysfunction. See, e.g., the abstract, page 2, and the claims. More specifically, sildenafil selectively inhibits PDEv enzyme and lead to an elevation of cGMP levels in corpus cavernosum tissue. The elevation of cGMP levels in corpus cavernosum tissue cause the tissue relaxation and consequent penile erection. See, page 9, the last paragraph bridging to page 10 in WO 94/28902.

8. WO 94/28902 does not teach expressly the employment of the treatment for man with injured spinal cord.

Art Unit: 1617

9. However, Tay et al. teaches that erectile dysfunction caused by injured spinal cord may be psychogenic, not organic. See the abstract. Berretta et al. and Chancellor et al. teach that vasoactive compounds are known to be useful for treatment of erectile dysfunction in men with injured spinal cord. See the abstracts.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the vasoactive compounds herein for the treatment of ED in men with spinal cord injury, including those who exhibits essentially no residual erectile function.

10. A person of ordinary skill in the art would have been motivated to employ the vasoactive, compounds herein for the treatment of ED in men with spinal cord injury, who exhibits essentially no residual erectile function because the general established mechanism of sildenafil indicates it will be useful for treatment of ED in men with proper corpus cavernosum tissue, including those with injured spinal cord. A person of ordinary skill in the art would have reasonable expected that sildenafil would be useful for treatment of ED in men including those exhibits essentially no residual erectile function, particularly in view of the fact that not all spinal cord injuries cause erectile dysfunction and not all the erectile dysfunction caused by spinal cord injury are organic. Further, a person of ordinary skill in the art would have been motivated to employ the vasoactive compounds herein for the treatment of ED in men with spinal cord injury because vasoactive compounds useful for treating erectile dysfunction are known to be useful for treating erectile dysfunction caused by spinal cord injury. Finally, an agent known to be useful for treating erectile dysfunction caused by spinal cord injury in men would have reasonably

Art Unit: 1617

expected to be useful for treating erectile dysfunction caused by spinal cord injury in any men, including those who exhibit essentially no residue erectile function.

Response to the Arguments

11. The declaration filed on February 8, 2002 under 37 CFR 1.131 is sufficient to overcome the Derry reference and Doherty Jr. et al. reference.

12. Applicants' remarks submitted February 8, 2002 have been fully considered, but are not persuasive for reasons discussed below.

13. Applicant's arguments with respect to claims 1-2 and 5-10 have been considered but are moot in view of the new ground(s) of rejection.

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., erectile dysfunction caused by nerve damage) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Specifically, as discussed above, A person of ordinary skill in the art would have reasonable expected that sildenafil would be useful for treatment of ED in men including those exhibits essentially no residual erectile function, particularly in view of the fact that not all spinal cord injuries cause erectile dysfunction and not all the erectile dysfunction caused by spinal cord injury are organic. Further, even for the erectile dysfunction is caused by nerve damage, the method is still prima facie obvious for reasons discussed above, specifically, vasoactive compounds are known to be effective in treating erectile dysfunction caused by spinal code injuries.

Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner

A handwritten signature in black ink, appearing to read 'S. Wang' with a stylized flourish at the end.

Shengjun Wang

April 16, 2002